

Serial No. 09/990,911  
Attorney Docket No. 65678-0042

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: BLY ET AL.

Serial No.: 09/990,911

Group Art Unit: 3621

Filed: 11/14/2001

Examiner: HEWITT II, Calvin L.

For: SYSTEM AND METHOD FOR DISPOSING OF ASSETS

Attorney Docket No.: 65678-0042

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Date: August 9, 2005	Signature: <u>Heather Edwards</u> Name: <u>Heather Edwards</u>

**AMENDED APPEAL BRIEF**

Dear Sir:

This appeal is from the decision of the Primary Examiner dated December 17, 2004 ("Final Office Action"), finally rejecting claims 1-23, which are reproduced as an Appendix to this brief. The Notice of Appeal was filed on March 16, 2005. This application was filed on November 14, 2001. An Appeal Brief was filed on May 5, 2005. This Amended Appeal Brief is filed to remedy an alleged defect noted by the Examiner in the "Communication Re: Appeal" mailed August 1, 2005 (paper no. 20050719). Specifically, the Examiner required that we have a section entitled "Evidence Appendix" even though there is no evidence to be appended. Submitted herewith are two additional copies of this Amended Appeal Brief.

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### **I. REAL PARTY IN INTEREST**

The Real Party-In-Interest is Dana Corporation, located at 4500 Dorr Street, P.O. Box 1000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the U.S. Patent Application identified by Serial No. 09/990,911 on May 15, 2003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

### **II. RELATED APPEALS AND INTERFERENCES**

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289. On January 7, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 16 and 21-48). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix B. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,000, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,000.

On October 9, 2003, Appellant filed a notice of appeal, and on December 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,343, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,343.

On October 24, 2003, Appellant filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after Appellant had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. In response, Appellant submitted an Amendment Pursuant to 37 C.F.R. §1.116 and a Notice of Appeal, both dated January 20, 2004. An Advisory Action was mailed on February 2, 2004.

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Appellant subsequently filed an Appeal Brief on April 20, 2004. The application at issue in this appeal is a C-I-P application claiming priority from application 09/503,671.

On December 12, 2003, Appellant filed a notice of appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/702,363, filed October 31, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/702,363.

On December 12, 2003, Appellant filed a notice to appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial Number 09/653,735, filed September 1, 2000 as a C-I-P application claiming priority from the following applications: U.S. Application Serial No. 09/441,289 filed November 16, 1999; U.S. Provisional Application Serial No. 60/166,042 filed November 17, 1999; U.S. Application Serial No. 09/503,671 filed February 14, 2000; U.S. Application Serial No. 09/504,000 filed February 14, 2000; and U.S. Application Serial No. 09/504,343 filed February 14, 2000. On April 26, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 1-8 and 12-24). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix C. The application at issue in this appeal is a C-I-P application claiming priority from application 09/653,735.

On May 4, 2004, Appellant filed a notice to appeal, and on July 1, 2004 Appellant filed an Appeal Brief, appealing to the final rejection of U.S. Application Serial No. 09/714,702, filed November 16, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/714,702.

### **III. STATUS OF CLAIMS**

Claims 1-23 are pending, and are the subject of this Appeal. Claims 1, 17, and 21 are independent claims. No claims have been amended during prosecution of this patent application.

In the Final Office Action, claims 1-23 were rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter. Claims 12, 17, and 22 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the

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subject matter which Applicants regard as their invention. Claims 1-23 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,067,525 ("Johnson") in view of U.S. Patent No. 6,236,990 ("Geller").<sup>1</sup>

#### **IV. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final rejection. A copy of all claims on appeal is attached hereto as an Appendix.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

An electronic system is provided for facilitating transactions, particularly rental transactions. The electronic system provides, in effect, a "virtual" rental fleet available to a user of the system, such as a dealer. The system includes an asset configuration unit, a market database, a market search module, and a communications interface. (Specification, page 4, lines 18-24.)

The configuration unit is responsive to input data, provided by a first user of the system, for generating a profile of an asset. The asset profile comprises asset specification data and a bid definition. In a preferred embodiment the bid definition outlines parameters associated with a rental transaction of the asset. The market database is configured to store a plurality of asset profiles. The market search module is configured to search the market database, based on search parameters specified by a second user, and generate an identification of assets. The bid module is configured to allow the second user to select one of the assets on which to bid. The bid module is also adapted to provide rental options to the second user, based on the bid definition for the asset. Finally, the communications interface is configured for facilitating the electronic remote access by the second user of the system. (Specification, page 4, line 25 – page 5, line 7.)

Accordingly, a dealer or the like is provided access to a "virtual" rental fleet of assets, some of which are not owned or controlled by the dealer. The system allows a user, such as a dealer, to satisfy the requirements of the dealer's end-user customer without having to maintain

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<sup>1</sup> Paragraph 7 of the Final Office Action does not initially identify Geller as a basis for the Section 103 rejection of claims 1-23. However, inasmuch as the Examiner acknowledged certain deficiencies of Johnson in the body of the rejection and allegedly cures these deficiencies with Geller (*see* Final Office Action, page 7), it is clear that claims 1-23 in fact stand rejected as unpatentable over Johnson in view of Geller.

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infrequently used items in the dealer's own rental fleet (which experience low utilization rates and thus low returns on investment.) Additionally, the electronic system also allows a user, such as a dealer having its own under-utilized assets, to consign assets for rental by third parties, thereby allowing an increased, effective utilization rate. (Specification, page 4, lines 8-18.)

Further, an electronic system is provided for facilitating transactions, including, for example, asset disposal transactions. The system, according to this aspect of the present invention, provides detailed information concerning an asset, including the maintenance history data so that the user, a potential purchaser, rentee or lessee, may evaluate the asset. The system includes a first database, a market search module, and a communications interface. (Specification, page 5, lines 19-26.)

In a preferred embodiment, the first database is configured to store information associated with a plurality of assets, such as pieces of industrial equipment. The market search module is configured to search the first database, based on search parameters specified by the user in anticipation of at least one of a purchase, rental and lease transaction. The market search module is also adapted to generate an identification of assets in accordance with the specified search parameters. At least one of the identified assets has a description that includes maintenance history data of the asset. The communications interface is configured to facilitate electronic remote access of the system by the user, which, in one embodiment, occurs over the Internet. (Specification, page 5, line 27, page 6, line 6.)

The electronic system then maximizes value extraction related to the asset by making detailed information concerning the asset readily available to the user. In particular, the maintenance history of the asset constitutes information that may increase the price obtained for the asset. For example, the maintenance history data is particularly important to a dealer class of users of the system who anticipate sub-renting or sub-leasing the asset for a short term, inasmuch as a common commercial practice places the responsibility of maintenance on the dealer, not the end-user customer. Availability of information such as maintenance history data electronically, and immediately, substantially minimizes or eliminates the cost associated with information acquisition. (Specification, page 6, lines 7-20.)

In a refinement of the proposed asset disposition, a subsystem is disclosed, which compares a subset of all assets within the system with a series of pre-defined conditions to

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determine if an action needs to be taken with respect to asset disposition. If a pre-defined condition is met, the system provides a ranked hierarchy of options based on the pre-defined condition that has been met. Associated with each option is the cost of invoking it, and the reasons why it is recommended for consideration. The hierarchy of options and the option determination assumptions are optionally reviewed and then presented to the asset user for consideration. (Specification, page 6, lines 21-32.)

**V. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 1-23 are patentable under 35 U.S.C. § 101.
2. Whether claims 12, 17, and 22 are patentable under 35 U.S.C. § 112.
3. Whether Johnson teaches or suggests “a set of predefined conditions” as required by claims 1, 17, and 21 (and therefore by each of claims 1-23).
4. Whether the Examiner stated a *prima facie* case of obviousness in rejecting claims 1-23.
5. Whether Johnson and Geller are capable of a combination that renders claims 1-23 obvious.
6. Whether Geller teaches or suggests “a hierarchy of disposition options” as required by claims 1, 17, and 21 (and therefore by each of claims 1-23).
7. Whether Johnson or Geller teaches or suggests “at least one of said conditions being met when an asset approaches the end of a lease term,” as is required by claims 3 and 18.
8. Whether Johnson or Geller teaches or suggests a “cost variable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives,” as is required by claims 7 and 18.
9. Whether Johnson or Geller teaches or suggests “a manual check and confirmation of said hierarchy of options,” as is required by claims 12, 17, and 22.

**VI. ARGUMENT**

**A. Claims 1-23 Are Patentable Under 35 U.S.C. § 101.**

The Examiner’s basis for rejecting claims 1-23 under 35 U.S.C. § 101 was an allegation that Appellants’

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claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. Claims 1, 17, and 21 use the term "database". However, in the context of [Applicants'] claims a database can be a notebook, or even a piece of paper. Hence, the claimed invention does not promote the progress of science and the useful arts.

(Final Office Action, page 4.) However, the provision of the United States Constitution (Article I, § 8) from which the Examiner appears to quote notwithstanding, Section 101<sup>2</sup> does not require that a claimed invention "promote the progress of science and the useful arts." See 35 U.S.C. § 101. Nor does Section 101 require that a "claimed invention . . . fall within the technological arts." See *id.* Accordingly, the Section 101 rejection of claims 1-23 should be reversed for the sole reason that the bases for the rejection are simply not supported by the plain language of Section 101.

Further, assuming *arguendo* that the Examiner has properly construed Appellants' claims, there is no reason why a claim requiring use of a notebook or a piece of paper would not be patentable under Section 101. Appellants' claims plainly recite systems and methods that produce useful, concrete, and tangible results, and therefore are clearly patentable under Section 101. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

Accordingly, for any of the foregoing reasons, the Examiner's rejection of claims 1-23 under Section 101 should be reversed.

**B. Claims 12, 17, and 22 are Patentable Under 35 U.S.C. § 112.**

Claims 12, 17, and 22 each recite "a manual check and confirmation of said hierarchy of options." The Final Office Action (page 5) states that this limitation fails to meet the requirement of 35 U.S.C. § 112, second paragraph, to recite "claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Examiner contended that the recitation of a "manual check" is a recitation of "limitations that occur outside the system." However, the recited manual check is clearly disclosed in paragraph

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<sup>2</sup> Section 101 states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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122 of Appellants' Specification, which explains that in one embodiment "the proposed options [in a hierarchy of options] are manually reviewed." Appellants' Specification thus makes clear that they regarded the limitation of "a manual check and confirmation of said hierarchy of options" as being included in the subject matter that they regarded as their invention. Accordingly, the Examiner's rejection of claims 12, 17, and 22 under Section 112 should be reversed.

**C. Claims 1-23 Are Patentable Under 35 U.S.C. § 103.**

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Johnson in view of Geller. Even if Johnson and Geller did teach or suggest all of Appellants' claim limitations, which, as discussed below, they do not, the prior art of record lacks motivation to combine these references. Indeed, as is also discussed below, the Examiner failed to state any motivation to combine Johnson and Geller, nor did the Examiner demonstrate that attempting such a combination would have had a reasonable expectation of success. In fact, because Johnson teaches a system for assisting product sellers, and Geller teaches a system for assisting product purchasers, Johnson and Geller are simply incapable of combination. Accordingly, for at least the independent reasons explained below, the Section 103 rejection of claims 1-23 should be reversed.

**1. Johnson Does Not Teach Or Suggest "a set of pre-defined conditions" As Required By Claims 1, 17, and 21.**

Claims 1 and 17 each recite "a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information [associated with a plurality of assets] within said system." Similarly, claim 21 recites "analyzing said information [associated with a plurality of assets] in accordance with a set of pre-defined conditions." Appellants' Specification (paragraph 114) provides helpful examples of "predefined conditions":

The pre-defined conditions include either a time variable or a cost variable. For example, one condition using a time variable involves the natural end of an asset lease – including, for example a set time period such as six (6) months prior to an end of a lease. Thus, the time variable is associated with the passage of time. A second condition using a time variable includes a situation such as when a particular asset has excessive usage compared to its time (e.g., hours) in service. An example condition using a cost variable involves an over usage of an asset, wherein based on such over usage, penalties begin to be invoked. Another example condition using a cost variable results when an analysis shows that the cost of leasing an asset appears to be higher than a threshold level when



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compared to other asset usage options that are immediately available to the asset user (e.g., a lessee) such as by purchasing more assets at a lower cost or reallocating existing assets between locations. It is also possible to develop pre-defined conditions using a combination of time and cost variables. For example, an excessive usage criteria may involve both a time element and a cost element.

Contrary to the Examiner's assertion (Final Office Action, pages 5-6), Johnson nowhere teaches or suggests the forgoing claim limitations relating to "pre-defined conditions."

Johnson is directed toward a sales force automation system. (Johnson, Abstract.) Accordingly, the portions of Johnson cited by the Examiner disclose a series of modules to aid in a product sales process, beginning with a "configuration module" used by a salesperson "to accurately configure and price a product that passes engineering, manufacturing, and customer requirements." (Johnson, 13: 46-48.) Johnson's configuration module (as well as the rest of Johnson's system used after the configuration module) has nothing to do with pre-defined conditions related to a recommendation of asset disposition. Instead, Johnson's configuration module is intended to support sales of products that might not have even been manufactured, and have not been sold or used, at the time of sale. Therefore, Johnson cannot possibly teach or suggest the recited analysis of information related to asset usage that is clearly required by claims 1, 17, and 21. Johnson at most teaches analyzing product prices, specifications, features and functions, etc., *i.e.*, descriptions of a type of product, and offers no hint of analyzing information associated with actual assets. Accordingly, the pre-defined conditions required by claims 1, 17, and 21 simply could not exist in Johnson's system.

Perhaps more importantly, Johnson does not teach or suggest any "pre-defined conditions" at all. Rather, Johnson's series of modules accept inputs and performs calculations based on those inputs. For example Johnson's "quotation module" takes into account "unit price, quantity, tradein value, discounts, fees, and taxes" and thereby "facilitates calculation and preparation of a bottom line quotation." (Johnson, 14: 22-25.) Similarly, to take another example, Johnson's "finance module" is designed "to assist the salesperson in quickly calculating and presenting finance or lease alternatives to customers based on information collected from other modules." (Johnson, 15: 17-20.) In sum, Johnson teaches at most performing pre-determined *calculations*, but nowhere suggests that those calculations depend on any pre-defined *conditions*, much less pre-defined conditions based on an analysis of information associated with a plurality of assets, as is required by claims 1, 17, and 21. And even if Johnson

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did disclose pre-determined conditions, Johnson contains absolutely no teaching or suggestion of pre-determined conditions used "to determine if an action needs to be taken with respect to asset disposition." (See Specification, paragraph 114.)

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reasons, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom. Therefore, the Examiner's rejection of claims 1-23 under Section 103 should be reversed.

**2. Neither Johnson Nor Geller Teaches Or Suggests a "hierarchy of disposition options" As Required By Claims 1, 17, and 21.**

Claims 1 and 17 recite "a hierarchy of disposition options generated by said system based on said at least one of said conditions." Similarly, claim 21 recites "recommending asset disposition using a hierarchy of disposition options." Johnson, as the Examiner acknowledges, does "not provide a hierarchy of options." (Final Office Action, page 7.) Further, Geller does not cure the deficiencies of Johnson for at least three reasons. First, the Examiner has failed to meet his burden of stating a *prima facie* case of obviousness for the combination of Johnson and Geller at least because the Examiner has provided no motivation to modify Johnson with the alleged teachings of Geller. Second, Johnson and Geller are incapable of being combined to meet Appellants' claim limitations. Third, Geller fails to teach or suggest "a hierarchy of disposition options," and therefore even if Johnson and Geller could be combined, such a combination would not render claims 1, 17, and 21 obvious.

**a. The Examiner Failed To State A *Prima Facie* Case Of Obviousness.**

Section 2142 of the MPEP explains the Examiner's burden of stating a *prima facie* case of obviousness as follows:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant . . . . To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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Here, the Examiner has simply failed to state any motivation at all to combine Johnson and Geller to meet Appellants' claim limitations, much less point to any such motivation in the prior art. Rather, the Examiner has simply made a rejection of the form "Johnson teaches X but not Y; Geller teaches Y; therefore it would have been obvious to combine Johnson and Geller." (*See* Final Office Action, page 7.) Nor has the Examiner stated, much less shown from the prior art, that a combination of Johnson and Geller would have any reasonable expectation of success.

The Examiner has wholly failed to state a *prima facie* case of obviousness with respect to claims 1, 17, and 21. Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

**b. Johnson and Geller Are Incapable Of Combination.**

Not only has the Examiner failed to show that there would have been a reasonable expectation of success for one of ordinary skill in the art attempting to combine Johnson and Geller, but Johnson and Geller are, in fact, incapable of combination. Johnson, as noted above, discloses and claims a sales automation system designed to assist salespersons in selling products. Geller, on the other hand, teaches a system to assist shoppers in selecting products from a catalog. (Geller, Abstract, Fig. 3.) The Examiner provides no explanation of how Johnson's system for assisting product *sellers* could be combined with Geller's system for assisting product *purchasers*. Indeed, Johnson offers absolutely no teaching or suggestion that his system could or should be adapted for use by shoppers, rather than salespersons. Clearly, any modification of Johnson with teachings from Geller would be inoperable. That is, even if Geller did teach presenting a hierarchy of asset disposition options to a potential purchaser, which it does not, a modification of Johnson with Geller's teaching would be pointless, because Johnson's system does not enable use by potential purchasers. Thus, any feature from Geller imported into Johnson simply would have no effect. i.e., Johnson and Geller could not have been combined by one of ordinary skill in the art.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

**c. Geller Fails To Teach "a hierarchy of disposition options."**

As noted above, claims 1, 17, and 21 each contain clear limitations requiring "a hierarchy of disposition options" for disposing of an asset. The Examiner fails to even contend that Geller anticipates these claim limitations, stating that Geller teaches "a ranking system that allows a

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user to rank products.” (Final Office Action , page 7.) Geller’s product ranking is clearly different from the recited “hierarchy of disposition options,” which, as Appellants’ Specification (e.g., paragraph 129) makes clear, refers to an order of presenting, to an asset user, different options for disposing of the asset. Thus, Appellants’ claims have nothing at all to do with ranking products, and, in fact, have nothing to do with ranking assets. Moreover, even if “a hierarchy of disposition options” was a ranking of dispositions, such a ranking is clearly different than a ranking of products. In sum, claims 1, 17, and 21 recite “a hierarchy of disposition options” for disposing of an asset, which is in no way taught or suggested by Geller’s system for ranking products.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reason, as are claims 2-16, 18-20, and 22-23, depending respectively therefrom.

**3. Appellants’ Dependent Claims Are Separately Patentable.**

As Appellants argued in their paper filed September 14, 2004, the prior art of record fails to teach or suggest the limitations of their dependent claims. For example, as discussed herein below, claims 3, 7, 12, 18, and 22 are clearly patentable over Johnson and Geller.

**a. Johnson Fails To Teach or Suggest The Limitations Of Claims 3 And 18.**

Claims 3 and 18 recite “at least one of said conditions being met when an asset approaches the end of a lease term.” The Final Office Action did not address this claim limitation. Further, as noted above, Johnson teaches a sales force automation system for configuring products, and managing product sales. Accordingly, Johnson does not teach or suggest anything having to do with an asset lease term, much less anything related to “conditions being met when an asset approaches the end of a lease term.” Claims 3 and 18 are each separately patentable for at least this reason.

**b. Johnson Fails To Teach or Suggest The Limitations Of Claims 7 And 18.**

Claims 7 and 18 recite a “cost variable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives.” Because, as noted above, Johnson provides no teaching or suggestion regarding asset leasing, Johnson cannot, and in fact does not, provide any teaching or suggestion of “a comparison of a cost of leasing an asset with a

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threshold level representing lower cost alternatives." Claims 7 and 18 are each separately patentable for at least this reason.

**c. Johnson Fails To Teach or Suggest The Limitations Of Claims 12, 17, And 22.**

Claims 12, 17, and 22 each recite "a manual check and confirmation of said hierarchy of options." In the Final Office Action (page 7), the Examiner asserted that these claims "recite additional non-functional data as they refer to steps/process/features that occur outside the system." Appellants respectfully suggest that the Board should reverse the rejection of claims 12, 17, and 22 under Section 103 because the basis for the rejection is unclear. The recited manual check is a limitation on how the claimed systems and method function, which limitation the Examiner apparently conceded is not found in the prior art of record. Inasmuch as the limitation is required by the plain language of the claims, it is unclear how it is "outside the system," or how the Examiner is relieved of the obligation to cite prior art reading on the limitation. Claims 12, 17, and 22 are each separately patentable for at least this reason.

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## VII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are patentable under 35 U.S.C. §§ 101 and 112, and are further novel over the cited references and therefore patentable under 35 U.S.C. § 103(a). The Examiner's rejection of claims 1-23 is improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.


Appellants believe no fee is due with this paper. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65678-0042, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to the above account.

Respectfully submitted,

Date: August 9, 2005

Customer No. 0102091

Telephone Number (248) 594-0600

By:   
Michael B. Stewart, Reg. No. 36,018  
Charles A. Bieneman, Reg. No. 51,472  
Rader Fishman and Grauer PLLC  
39533 Woodward Ave, Suite 140  
Bloomfield Hills, Michigan 48304  
*Attorneys for Applicants*

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### **APPENDIX A – CLAIMS ON APPEAL**

A complete listing of the claims that are the subject of this Appeal is as follows.

1. An electronic system for facilitating disposition of an asset currently under lease by an asset user, comprising:
  - at least one database configured to store information associated with a plurality of assets;
  - a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information within said system, at least one of said conditions being met; and
  - a hierarchy of disposition options generated by said system based on said at least one of said conditions, wherein said conditions and said options are chosen to reduce expense by maximizing return on investment to the asset user.
2. An electronic system as recited in claim 1, wherein said pre-defined conditions include at least one of a time variable and a cost variable.
3. An electronic system as recited in claim 2, wherein said time variable comprises a passage of time, said at least one of said conditions being met when an asset approaches the end of a lease term.
4. An electronic system as recited in claim 3, wherein said options include lease renewal; asset buyout; and asset return.
5. An electronic system as recited in claim 3, wherein said time variable comprises asset usage within a predetermined period of time, said at least one of said conditions being met when asset use exceeds a usage criteria based on time in service.
6. An electronic system as recited in claim 5, wherein said options include the leasing of additional assets to reduce the amount of use of a pre-existing asset.

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7. An electronic system as recited in claim 2, wherein said cost variable includes a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives.
8. An electronic system as recited in claim 7, wherein said options include the leasing of additional assets.
9. An electronic system as recited in claim 1, wherein said information includes asset identification data, maintenance history data, and lease term.
10. An electronic system as recited in claim 9, wherein said identification data comprises an asset make/model and serial number.
11. An electronic system as recited in claim 9, wherein said lease term includes at least two of a lease start date, a lease termination date, and a length of time between said lease start date and said lease termination date.
12. An electronic system as recited in claim 1, further comprising a manual check and confirmation of said hierarchy of options, wherein a rejection of said hierarchy generates feedback selectively modifying said availability of future options by said system.
13. An electronic system as recited in claim 1, wherein said options are presented to the asset user for consideration in order of expected acceptance.
14. An electronic system as recited in claim 1, wherein one of said options is a new lease, wherein upon acceptance of said new lease, a new asset is delivered to the asset user, an off-leased asset is picked up, and said off-leased asset is disposed.



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15. An electronic system as recited in claim 1, wherein one of said options is a renewed lease, wherein upon acceptance of said renewed lease renewal documents are executed by the asset user.

16. An electronic system as recited in claim 1, wherein one of said options is an asset buyout, wherein upon acceptance of said asset buyout, the asset is purchased.

17. An electronic system for facilitating disposition of an asset currently under lease by an asset user, comprising:

at least one database configured to store information associated with a plurality of assets;

a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information within said system, each of said conditions comprising at least one of a time variable and a cost variable, at least one of said conditions being met;

a hierarchy of disposition options generated by said system based on said at least one of said conditions, wherein said conditions and said options are chosen to reduce expense by maximizing return on investment to the asset user; and

a manual check and confirmation of said hierarchy of options, wherein a rejection of said hierarchy generates feedback selectively modifying said availability of future options by said system.

18. An electronic system as recited in claim 17, wherein said time variable comprising a passage of time, said at least one of said conditions being met when an asset approaches the end of a lease term or when asset usage exceeds a usage criteria based on time in service; and

said cost viable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives.

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19. An electronic system as recited in claim 17, said information including asset identification data, maintenance history data, and lease term, wherein said identification data comprises an asset make/model and serial number, and said lease term includes at least two of a lease start date, a lease termination date, and a length of time between said lease start date and said lease termination date.

20. An electronic system as recited in claim 17, wherein said options are presented to the asset user for consideration in order of expected acceptance, and wherein,

a first of said options comprises a new lease such that upon acceptance of said new lease, a new asset is delivered to the asset user, an off-leased asset is picked up, and said off-leased asset is disposed,

a second of said options is a renewed lease such that upon acceptance of said renewed lease renewal documents are executed by the asset user, and

a third of said options is an asset buyout such that upon acceptance of said asset buyout, the asset is purchased.

21. A method for facilitating disposition of an asset currently under lease an asset user, comprising the steps of:

configuring at least one database and storing information associated with a plurality of assets;

analyzing said information in accordance with a set of pre-defined conditions, each of said conditions comprising at least one of a time variable and a cost variable;

meeting at least one of said pre-defined conditions;

recommending asset disposition using a hierarchy of disposition options; and

selecting said conditions and said options by reducing expense and maximizing return on investment to the asset user.

22. A method as recited in claim 21, further comprising the step of:

instituting a manual check and confirmation of said hierarchy of options; and

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said rejection of said hierarchy generating feedback, selectively modifying said availability of future options by said system.

23. . An electronic system as recited in claim 21, including the further step presenting said hierarchy of options to the asset user for consideration in order of expected acceptance, and wherein,

a first of said options comprises a new lease such that upon accepting said new lease, delivering a new asset to the asset user and picking up and disposing of an off-leased asset,

a second of said options is a renewed lease such that upon accepting said renewed lease renewal, the asset user executing renewal documents, and

a third of said options is an asset buyout such that upon accepting said asset buyout, the asset user purchases the asset.

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**APPENDIX B – EVIDENCE APPENDIX**

In this Appeal, Appellants do not rely on any evidence submitted pursuant to 37 CF.R.F. §§ 1.130, 1.131, or 1.132, or on any other evidence entered by the Examiner.

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**APPENDIX C – THIS BOARD’S DECISION IN RELATED CASE 09/441,289**

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**APPENDIX D – THIS BOARD’S DECISION IN RELATED CASE 09/653,735**